

## REISSUE APPLICATION DECLARATION BY THE ASSIGNEE

Docket Number: 5/891-1-C1 Reissue

We hereby declare that:

My residence, post office address and citizenship are stated below next to my name.  
We are authorized to act on behalf of the following company: Dr. Karl Thomae GmbH  
and the title of my position with said company is:  
The entire title to the patent identified below is vested in said company.

Name of Patentee: Wolfgang GRELL, Rudolf HURNAUS, Gerhart GRISS (By Elizabeth GRISS, Executrix),  
Robert SAUTER, Manfred REIFFEN and Eckhard RUPPRECHT

Patent Number: 5,216,167

Date Patent Issued: June 1, 1993

Title of Invention: PHENYLACETIC ACID BENZYLAMIDES

We believe said patentee to be the original, first and sole or joint inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled:

PHENYLACETIC ACID BENZYLAMIDES

the specification of which

- is attached hereto.
- was filed on October 7, 1997, as reissue application number 08/946,602,  
and was or will be amended on

We have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

We acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

We verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

- by reason of a defective specification or drawing, said defects being described below.
- by reason of the patentee claiming more or less than he had the right to claim in the patent, said excess or insufficiency in the claims being specified below.
- by reason of other errors, described below.

The errors relied upon in the above statement, and how the errors occurred, are as follows:

The terminal disclaimer filed on August 6, 1992, in connection with U.S. Serial No. 07/495,820, the application from which U.S. patent No. 5,216,167 issued, disclaimed only the term of any patent issuing from that application subsequent to October 10, 2006, *i.e.*, the expiration date of U.S. patent no. 4,873,080. However, both U.S. patent nos. 4,873,080 and 4,863,724 are co-owned by assignee Dr. Karl Thomae GmbH, and both disclose and claim subject matter relating to repaglinide. Thus, in an abundance of caution, the assignee believes that U.S. patent no. 5,216,167 should be terminally disclaimed over both U.S. patent nos. 4,873,080 and 4,863,724. Accordingly, a terminal disclaimer which disclaims the term of U.S. patent no. 5,216,167 subsequent September 5, 2006, *i.e.*, the expiration date of U.S. patent no. 4,863,724, is submitted herewith.

The errors described above arose without any deceptive intention on the part of the applicant.

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the patent and Trademark Office connected therewith.

## Name(s)

Robert P. Raymond  
Mary-Ellen M. Devlin  
Alan R. Stempel  
Anthony P. Bottino

Registration No.:  
25,089  
27,928  
28,991  
41,629

Correspondence Address: Direct all communications about the application to:

Customer Number

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Type Customer Number Here

Place Customer  
Number Bar Code  
Label here

OR

<input checked="" type="checkbox"/> Firm or Individual Name	Robert P. Raymond				
Address	c/o Boehringer Ingelheim Corp. 900 Ridgebury Road				
Address					
City	Ridgefield	State	CT	Zip	06877
Country	US				
Telephone	203-798-4864	Fax	203-791-6183		

We, representing the assignee, hereby consent to the filing of a reissue application.

We hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full name of person signing (given name, family name)	Full name of person signing (given name, family name)
Signature ppa.	Signature ppa.
Date	Date
Residence	Residence
Citizenship:	Citizenship:
Post Office Address	Post Office Address

(Page 2 of 2)

Under the Paperwork Reduction Act of 1995, no persons required to respond to a collection of information unless it displays a valid OMB control number.

**REISSUE APPLICATION DECLARATION BY THE INVENTOR**Docket Number (Optional)  
5/891-1-C1 Reissue

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in patent number 5,216,167, granted June 1, 1993, and for which a reissue patent is sought on the invention entitled:

**PHENYLACETIC ACID BENZYLAMIDES**

the specification of which

- is attached hereto
- was filed on October 7, 1997, as reissue application number 08/946,602 and was or will be amended on \_\_\_\_\_ (if applicable)



I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability is defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

- by reason of a defective specification or drawing.
- by reason of the patentee claiming more or less than he had the right to claim in the patent.
- by reason of other errors.

At least one error upon which reissue is based is described as follows:

The terminal disclaimer filed on August 6, 1992, in connection with U.S. Serial No. 07/495,820, the application from which U.S. patent No. 5,216,167 issued, disclaimed only the term of any patent issuing from that application subsequent to October 10, 2006, *i.e.*, the expiration date of U.S. patent no. 4,873,080. However, both U.S. patent nos. 4,873,080 and 4,863,724 are co-owned by assignee Dr. Karl Thomae GmbH, and both disclose and claim subject matter relating to repaglinide. Thus, in an abundance of caution, the assignee believes that U.S. patent no. 5,216,167 should be terminally disclaimed over both U.S. patent nos. 4,873,080 and 4,863,724. Accordingly, a terminal disclaimer which disclaims the term of U.S. patent no. 5,216,167 subsequent September 5, 2006, *i.e.*, the expiration date of U.S. patent no. 4,863,724, is submitted herewith.

(Page 1 of 3)

Burden Hour Statement: This form is estimated to take 0.5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Office, Patent and Trademark Office, Washington, DC 20231.

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## (REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)

Docket Number (Optional)  
5/891-1-C1 Reissue

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant. As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Name(s)

Dr. Robert P. Raymond

Registration Number

25,089

Mary-Ellen M. Devlin

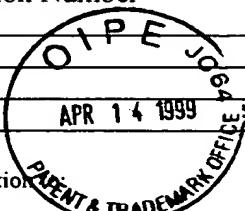
27,928

Alan R. Stempel

28,991

Anthony P. Bottino

41,629



Correspondence Address: Direct all communications about the application to:

 Customer Number
Place Customer Number Bar  
Code Label here**OR***Type Customer No. here* Firm or  
Individual NameBoehringer Ingelheim Corporation  
Attn: Dr. R.P. Raymond

Address 900 Ridgebury Road, P.O. Box 368

Address

City Ridgefield State CT ZIP 06877-0368

Country US

Telephone 203-798-4866 FAX 203-791-6183

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full name of sole or first inventor (given name, family name)

Wolfgang GRELL

Inventor's signature

Residence

Date

Post Office Address

Citizenship

Full name of second or joint inventor (given name, family name)

Rudolf HURNAUS

Inventor's signature

Residence

Date

Post Office Address

Citizenship

Full name of third or joint inventor (given name, family name)

Gerhart GRISS (By Elizabeth GRISS, Executrix)

Inventor's signature

Residence

Date

Post Office Address

Citizenship

 Additional joint inventors are named on separately numbered sheets attached hereto.

Page 2 of 3

(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 3)		Docket Number (Optional) 5/891-1-C1 Reissue
Full name of sole or first inventor (given name, family name) <b>Robert SAUTER</b>		
Inventor's signature	Date	
Residence	Citizenship	
Post Office Address		
Full name of second or joint inventor (given name, family name) <b>Manfred REIFFEN</b>		
Inventor's signature	Date	
Residence	Citizenship	
Post Office Address		
Full name of third or joint inventor (given name, family name) <b>Eckhard RUPPRECHT</b>		
Inventor's signature	Date	
Residence	Citizenship	
Post Office Address		
<input checked="" type="checkbox"/> Additional joint inventors are named on separately numbered sheets attached hereto.		